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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/749,837      | 12/28/2000  | Judith C. Espejo     | BS00-157            | 5211             |

28970 7590 10/06/2003

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EXAMINER

SMITH, SHEILA B

| ART UNIT | PAPER NUMBER |
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2681

8

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NO./<br>CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /<br>PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
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**Commissioner for Patents**

## Office Action Summary

Application No.

09/749,837

Applicant(s)

ESPEJO ET AL.

Examiner

Sheila B. Smith

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2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartmaier et al. (U. S. Patent Number 6,393,269) in view of Katz et al. (U. S. Patent Number 6,242,706).

Regarding *claims 1-4*, Hartmaier et al. discloses essentially all the claimed invention as set forth in the instant application, further Hartmaier et al. discloses a signaling system and method for network based pre-paid wireless telephone service. In addition Hartmaier et al. discloses a interactive voice response system for pre-paid wireless services comprising: a peripheral device (101,102) in communication with a mobile switching system (103), the mobile switching system capable of communicating with at least one wireless device (106) as exhibited in figure 1 and disclosed in column 3 lines 54-65 and the wherein the system responds to the information by reciting a rate plan that is the current rate plan and features of the customer disclosed in column 4 lines 1-5, however Hartmaier et al. fails to specifically disclose the use of an IVR application on the peripheral device comprising a menu driven system adapted to receive information from a customer.

In the same field of endeavor, Katz et al. discloses a method and system for transferring telecommunication-time units among accounts and exchanging same for goods or services. In addition Katz et al. discloses the use of an IVR application on the peripheral device comprising

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a menu driven system adapted to receive information from a customer, as disclosed in column 9 lines 44-48.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to improve Hartmaier et al. by modifying a signaling system and method for network based pre-paid wireless telephone service with an IVR application on the peripheral device comprising a menu driven system adapted to receive information from a customer as taught by Katz et al. for the purpose of preventing the user from waiting for the transfer and incurring added expense.

**Regarding claim 5**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the peripheral device is an SCP (101,102) that communicates with the mobile switching system (104) using IN TCAP messaging as disclosed in column 1 lines 61-63.

**Regarding claim 6**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the SCP communicates with an Intelligent Peripheral using TCP/IP as disclosed in column 1 lines 61-63 and column 2 lines 1-9.

**Regarding claim 7**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the SCP communicates with an Intelligent Peripheral using IN TCAP messaging as disclosed in column 1 lines 61-63 and column 2 lines 1-9.

**Regarding claim 8**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the peripheral device is an SCP that communicates with the mobile switching system using TCP/IP as disclosed in column 1 lines 61-63 and column 2 lines 1-9.

**Regarding claim 9**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the SCP communicates with an Intelligent Peripheral using TCP/IP as disclosed in column 1 lines 61-63 and column 2 lines 1-9.

**Regarding claim 10**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the SCP communicates with an Intelligent Peripheral using IN TCAP messaging as disclosed in column 1 lines 61-63 and column 2 lines 1-9.

**Regarding claim 11**, Hartmaier et al. discloses everything claimed as applied above (see claim 1), in addition Hartmaier et al. discloses the peripheral device is an SCP (101,102) that communicates with an Intelligent Peripheral (104), and wherein the Intelligent Peripheral plays voice messages through a voice path to the mobile switching system as disclosed in column 4 lines 29-37.

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***Citation of Pertinent Prior Art***

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Laybourn et al.*** (U. S. Patent Number 6,480,710) discloses system and method for managing prepaid wireless service;

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheila B. Smith whose telephone number is (703)305-0104. The examiner can normally be reached on Monday-Thursday 6:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 703-305-4040. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-0104.

S. Smith  
September 28, 2003

  
**SINH TRAN  
PRIMARY EXAMINER**